

REMARKS/ARGUMENTS

The claims under consideration are 1-11 and 13.

The Examiner has rejected Claims 1, 6-8 and 13 as being unpatentable over Fick (U.S. 4,842,911) in view of Bunyan (U.S. 6,054,198). Applicants respectfully request reconsideration in view of the following. Applicants claimed subject matter is directed to a heat conductive composite sheet of a two component system (a) a silicone resin and a heat conductive filler and (b) a heat conductive silicone rubber layer where the surface of the layer (a) opposite to layer (b) is capable of melting at a temperature of 40°C to 100°C.

The secondary reference to Bunyan is directed to the use of non-silicone material for thermal interface material. Accordingly, there is no motivation to combine the patent to Fick with that of Bunyan. In order for the combination of references to render an invention obvious, it must be obvious that their teaching can be combined. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

When the incentive to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the teachings is proper.

The mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. Citing references which merely indicate that isolated elements and/or features recited in the claims are known is not sufficient basis for concluding that the combination of claimed elements would have been obvious. The references, viewed by themselves and not in retrospect, must suggest doing what applicant has done.

With respect to the Fick patent ('911), the affidavit submitted under Rule 132, the comparative examples indicate that the pre-cured upper layer 7A of Fick is not capable of

melting at a temperature that ranges from 40°C to 100°C. However, the peroxide-cured silicone rubber sheet TC-A, the condensation silicone rubber sheet KE-3467 and the addition-cured silicone rubber sheet TC-200 TXS slightly soften but do not melt when the temperature rises from 23°C to 90°C. Applicants respectfully request withdrawal of the rejection of Claims 1, 6-8 and 13.

The Examiner further rejected Claims 2-3 as being unpatentable over Fick in view of Ahn (U.S. 6,482,888) and further in view of Bunyan. The Fick reference is rendered moot by the Applicants' declaration under 37 C.F.R. § 1.132 demonstrating that the pre-cured upper layer 7A of Fick is not capable of melting at a temperature that ranges from 40°C to 100°C. The Ahn patent ('888) is directed to the preparation of a silicone composition that finds uses for attaching electronic devices and encapsulating the wire winding. The Ahn reference fails to teach or remotely suggest the composite sheet (a two component, (a) heat softening conductive layer composition and (b) silicone rubber layer with a heat conductive filler). Accordingly, there is no motivation to combine Ahn and Bunyan for what is lacking in the Fick reference. The mere allegation that the differences between the claimed subject matter and the prior art are obvious does not create a presumption of unpatentability which forces an applicant to prove conclusively that the Patent Office is wrong. The ultimate legal conclusion of obviousness must be based on facts or records, not on the Examiner's unsupported allegation that a particular modification is well known and thus obvious. Subjective opinions are of little weight against contrary evidence.

Applicants respectfully request withdrawal of the rejection of Claims 2-3.

The Examiner rejected Claims 4, 5, 9, and 10 as being unpatentable over Fick in view of Anabuki (U.S. 6,506,828) in further view of Bunyan. The references to Fick and Bunyan have been discussed above and the arguments are equally applicable to the instantly rejected claims. The patent to Anabuki fails to teach or fairly suggest the composite sheets of the

instantly claimed subject matter, i.e., the heat conductive layer comprising a silicone resin and a silicone rubber layer. Consequently, there is no motivation to combine the references, especially since the declaration submitted under 37 C.F.R. § 1.132 clearly overcomes the Fick reference.

Applicants respectfully request withdrawal of the rejection of Claims 4, 5, 9 and 10.

Applicants respectfully submit that all of the presently-pending claims in this application are now in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Respectfully submitted,

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(OSMMN 06/04)



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